

II. Remarks

After entry of the amendment, claims 2-8, 10-17, 19-31, 33-40 and 104-106 and 117 are pending.

The specification and claims 2 and 23 have been amended to replace $(C(R_e)(R_f))_k$ -T-Q by $(C(R_o)(R_p))_k$ -T-Q. The definition of R_o and R_p are the same as that of R_e and R_f except that $(C(R_e)(R_f))_k$ -T-Q has been deleted from the definition of R_o and R_p , and is supported by the specification at, for example, page 19, lines 18-32.

Claim 116 has been canceled and replaced with claim 117 and is supported by the specification at, for example, page 16, line 32 to page 17, line 5.

As required by the PTO in the Communication dated April 27, 2005, Applicants have identified claims 4-8, 10-17, 19-31, 33-40 and 14-106 as being "withdrawn." The requirement to identify these claims as being "withdrawn" is completely inappropriate and directly contradicts the PTO's Petition Decision dated October 18, 2002. Applicants respectfully request that the Group Director consider the Petition from Restriction Requirement under 37 CFR § 1.144 that was filed on April 11, 2005, particularly in view of the PTO's prior Petition Decision dated October 18, 2002.

No issues of new matter should arise and entry of the amendment is respectfully requested.

Restriction Requirement

In response to the Restriction Requirement of August 16, 2004, Applicants elected Examiner's Group II, with traverse. In the Office Action dated January 13, 2005, the Examiner made the restriction requirement final. In view thereof, Applicants filed a Petition from Requirement for Restriction Under 37 C.F.R. § 1.144 on April 11, 2005.

Applicants respectfully request that the Petition be forwarded to the Group Director for timely consideration.

Rejection under 35 USC § 112, First Paragraph

Claim 116 is rejected under 35 USC § 112, first paragraph, as lacking enablement..

Claim 116 has been canceled and replaced with claim 117 to include the names of the prostaglandins disclosed in the specification at page 16, line 32 to page 17, line 5. As stated by the Examiner in the Office Action "the specification while being enabling for the prostaglandins

found on page 16, line 32 to page 17, line 5, does not reasonably provide enablement for all prostaglandins.” Accordingly, Applicants have modified claim 116 (new claim 117) to conform to the Examiner's statement regarding enablement.

In view of the above, Applicants respectfully submit that the claim satisfies the requirement under 35 USC § 112, first paragraph, and respectfully request that the rejection under this provision be withdrawn.

Rejection under 35 USC § 112, Second Paragraph

Claims 2 and 3 are rejected under 35 USC § 112, second paragraph, as being indefinite.

The claims have been editorially amendment. Claims 2 and 23 have been amended to replace $(C(R_e)(R_f))_k-T-Q$ by $(C(R_o)(R_p))_k-T-Q$. The definitions of R_o and R_p are the same as that of R_e and R_f except that " $(C(R_e)(R_f))_k-T-Q$ " has been deleted from the definition of R_o and R_p in response to the Examiner's rejection. The claims are supported by the specification at, for example, page 19, lines 18-32.

In view of the thereof, Applicants respectfully submit that the claims satisfy the requirement under 35 USC § 112, second paragraph, and respectfully request that the rejection under this provision be withdrawn.

Rejection under 35 USC § 103(a)

Claims 2 is rejected under 35 U.S.C. § 103(a) as being obvious over Del Soldato (WO 98/58910).

Applicants respectfully traverse the rejection and respectfully submit that the presently claimed invention is unobvious over the cited reference

Del Soldato was previously cited by the Patent Office in the Office Action dated November 25, 2004. In that Office Action, on page 3, lines 6-7, the Patent Office admitted that Del Soldato taught nitroprostaglandin compounds that are specifically excluded by the proviso in the claims. The compounds in claim 2 are structurally different from the compounds described by Del Soldato. There is no motivation or suggestion to make the compounds recited in claim 2 based on the compounds described by Del Soldato. The compounds in claim 2 are clearly not recited in Del Soldato and are structurally different from the compounds described in Del

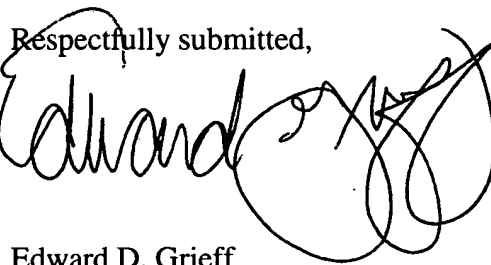
Soldato, and there is no motivation for one skilled in the art to make the compounds in claim 2 based on the teachings in Del Soldato.

In view thereof, Applicants respectfully submit that the presently claimed invention is unobvious over the cited reference, and respectfully request that the rejection under 35 USC § 103 be withdrawn.

Conclusion

Applicants respectfully request reconsideration and allowance of claims 2-8, 10-17, 19-31, 33-40 and 104-106 and 117.

Examiner Stockton is encouraged to contact the undersigned at 202-942-8453 concerning any questions about the present application.

Respectfully submitted,


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